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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,293	10/05/2004	Kiyoharu Oono	2144.0220000/RWE/RAS	9002
28393 7590 08/29/2007 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVE., N.W. WASHINGTON, DC 20005			EXAMINER FREDMAN, JEFFREY NORMAN	
			ART UNIT 1637	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/500,293

Applicant(s)

OONO ET AL.

Examiner

Jeffrey Fredman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 7-9 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 11, 2007 has been entered.

### ***Claim Interpretation***

2. The presence in claim 1 of the alternative "nucleic acid or protein" means that either can be bound to the LSI. This also requires interpretation regarding the amendment, which requires that the nucleic acid is "double stranded or circular". It is clear that this amendment can only apply to nucleic acids, not proteins, since the amendment would be unintelligible if proteins were meant. Consequently, the rejection using Nova is not changed. Mandecki also still applies in Mandecki teaches double stranded molecules bound to the LSI (as shown in figure 1).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 3, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mandecki et al (U.S. Patent 6,046,003) in view of Akram et al (U.S. Patent 6,250,192).

Mandecki teaches a method for producing a labeled nucleic acid (e.g., fluorescently-labeled target DNA bound to probe attached to the surface of the transponder), wherein the method comprises binding the nucleic acid (e.g., oligonucleotides) to a large scale integrated circuit (e.g., solid phase particles having a transponder associated with each particle), and recording specific information (e.g., the sequence of the oligonucleotide) on the large scale integrated circuit (column 1, lines 55 - column 2, line 6, column 17, lines 28-44).

Mandecki expressly exemplifies the situation where double stranded nucleic acid is bound to the transponder (see figure 1, where the nucleic acid shown in clearly double stranded).

With regard to claim 3, Mandecki teaches a method wherein a substrate (e.g., monoisocyanate) mediates the binding of a nucleic acid to the large scale integrated circuit (column 8, lines 21-45).

With regard to claim 7, Mandecki teaches recording specific information (e.g., the sequence of the oligonucleotide) on the large scale integrated circuit (column 1, lines 55 - column 2, line 6, column 17, lines 28-44).

With regard to claim 8, Mandecki teaches that a nucleic acid is bound to the LSI (see figure 1 and column 1, lines 55 to column 2, line 6).

Mandecki does not teach the use of integrated circuits with 320 million bits of memory (equivalent to 40 million bytes or 40 megabytes of memory).

Akram teaches the use of RFID integrated circuits with a capacity of 64 megabytes (see column 2, lines 1-15, especially line 9).

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify the Mandecki device to use larger integrated circuits since Mandecki expressly notes "The present invention can be practiced with different transponders, which might be of different dimensions and have different electronic memory capacity (see column 5, lines 57-60)." Akram teaches that "It may, however, be desirable to design and fabricate a semiconductor wafer having various integrated circuits and other semiconductor devices thereon, each of which may be of a different size. For example, in radio-frequency ID (RFID) applications, a battery, chip

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and antenna could be incorporated into the same wafer such that all semiconductor devices of an RFID electronic device are fabricated from a single semiconductor wafer.

Alternatively, memory dice of

different capacities, for example, 4, 16 and 64 megabyte DRAMs, might be fabricated on a single wafer to maximize the use of silicon "real estate" and reduce thieftage or waste of material near the periphery of the almost-circular (but for the flat) wafer (see column 2, lines 1-13)."

An ordinary practitioner, motivated by Mandecki to utilize different RFID transponders with different sizes and memory capacities, would have been motivated to use the RFID devices of Akram with 64 megabytes when performing the method on complex samples where the number of variants exceeds 320 million. Mandecki exemplifies a three base situation where there are sixty four different possibilities (see example 2). A situation where more than 320 million possibilities would occur would only require a situation of analyzing a 15 nucleotide variable region, since  $4^{15}$  equals a little over 1 trillion different possibilities. The ordinary practitioner would therefore be motivated to utilize the RFID device of Akram in the method of Mandecki when the oligonucleotide to be analyzed varied in 15 nucleotides or more in order to permit analysis of all of the possibilities.

6. Claims 1, 3, 5, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nova et al (U.S. Patent 5,741,462) in view of Akram et al (U.S. Patent 6,250,192).

Nova teaches a method for producing a labeled protein or gene (see abstract), wherein the method comprises binding the protein to a large scale integrated circuit (see column 29, line 45 to column 30, line 14, where antibodies are bound to the integrated circuit), and recording specific information that is characteristic of the peptide (see column 29, lines 50-55 where each antibody "is given a specific identification tag") on the large scale integrated circuit (see columns 29 and 30).

With regard to claim 3 and 9, Nova teaches a method wherein the peptide is bound to the large scale integrated circuit via a linker (see column 18, line 10, for example).

With regard to claim 5, Nova teaches an antibody mediates binding of a protein to the integrated circuit (see columns 29-30).

With regard to claim 7, Nova teaches recording specific information that is characteristic of the peptide (see column 29, lines 50-55 where each antibody "is given a specific identification tag")

Nova does not teach the use of integrated circuits with 320 million bits of memory (equivalent to 40 million bytes or 40 megabytes of memory).

Akram teaches the use of RFID integrated circuits with a capacity of 64 megabytes (see column 2, lines 1-15, especially line 9).

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify the Nova device to use larger integrated circuits

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since Nova expressly notes "Based on current semiconductor integrated circuit fabrication process capabilities, in a preferred embodiment the finished chip on which all of the listed components are integrated is on the order of 1 mm.times.1 mm [.about.40 mils.times.40 mils], with a memory capacity of 1024 bits. Greater memory capacity, where needed, and smaller chips, however, will be preferred. The chip may be larger to accommodate more memory if desired, or may be smaller as design rules permit smaller transistors and higher device densities (see column 21, lines 8-16)." Akram teaches that "It may, however, be desirable to design and fabricate a semiconductor wafer having various integrated circuits and other semiconductor devices thereon, each of which may be of a different size. For example, in radio-frequency ID (RFID) applications, a battery, chip and antenna could be incorporated into the same wafer such that all semiconductor devices of an RFID electronic device are fabricated from a single semiconductor wafer. Alternatively, memory dice of different capacities, for example, 4, 16 and 64 megabyte DRAMs, might be fabricated on a single wafer to maximize the use of silicon "real estate" and reduce thieftage or waste of material near the periphery of the almost-circular (but for the flat) wafer (see column 2, lines 1-13)."

An ordinary practitioner, motivated by Nova to utilize different integrated circuits with greater memory capacity where needed, would have been motivated to use the RFID devices of Akram with 64 megabytes when performing the method on complex samples where the number of variants exceeds 320 million. A situation where more than 320 million possibilities would occur would only require a situation of analyzing a 15 nucleotide variable region, since  $4^{15}$  equals a little over 1 trillion different possibilities.



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The ordinary practitioner would therefore be motivated to utilize the RFID device of Akram in the method of Nova when the oligonucleotide to be analyzed varied in 15 nucleotides or more in order to permit analysis of all of the possibilities.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mandecki et al (U.S. Patent 6,046,003) in view of Akram et al (U.S. Patent 6,250,192) and further in view of Stavrianopoulos et al (U.S. Patent 4,994,373).

Mandecki in view of Akram teach the limitations of claims 1, 3, 7 and 8 as discussed above.

Mandecki does not teach the specific substrates of claim 4.

Stavrianopoulos teaches attachment of nucleic acids to plastic matrices (see column 12, lines 5-15, for example).

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use the epoxy resin of Stavrianopoulos to attach the nucleic acids of Mandecki in view of Akram since Stavrianopoulos notes "An improved capability for fixing or immobilization of DNA to non-porous siliceous solid supports, such as glass and plastic, is also provided by treatment with a coating of an epoxy resin. (see column 12, lines 5-15)". An ordinary practitioner would have been motivated to use the epoxy resin of Stavrianopoulos in order to improve the ability of the

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DNA to be fixed to the plastic solid supports of Mandecki as expressly suggested by Stavrianopoulos.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nova et al (U.S. Patent 5,741,462) in view of Akram and further in view of Stavrianopoulos et al (U.S. Patent 4,994,373).

Nova in view of Akram teach the limitations of claims 1, 3, 5, 7 and 9 as discussed above.

Nova teaches a variety of synthetic plastic matrices as substrates at column 17, but Nova does not teach the specific substrates of claim 4.

Stavrianopoulos teaches attachment of nucleic acids to plastic matrices such as those of Nova using epoxy resin (see column 12, lines 5-15, for example).

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use the epoxy resin of Stavrianopoulos to attach the nucleic acids or proteins of Nova in view of Akram since Stavrianopoulos notes "An improved capability for fixing or immobilization of DNA to non-porous siliceous solid supports, such as glass and plastic, is also provided by treatment with a coating of an epoxy resin. (see column 12, lines 5-15)". An ordinary practitioner would have been motivated to use the epoxy resin of Stavrianopoulos in order to improve the ability of the DNA to be fixed to the plastic solid supports of Nova as expressly suggested by Stavrianopoulos.

***Allowable Subject Matter***

9. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: Claim 6 is drawn to an embodiment with two differences from claim 1, a requirement that the protein is attached to the integrated circuit via the sugar chain and a requirement that some information regarding the sugar chain is encoded on the integrated circuit. While Keogh does teach attachment of proteins to supports via sugar chains, Keogh does not suggest encoding this information onto an integrated circuit. While Mandecki teaches encoding the sequence of the nucleic acid onto the circuit, there is no suggestion to encode the linker information, to which the sugar in claim 6 corresponds. Therefore, there is no suggestion in the prior art to both attach a protein by a sugar chain and encode the sugar chain information onto the integrated circuit.

***Response to Arguments***

11. Applicant's arguments filed July 11, 2007 have been fully considered but they are not persuasive.

Applicant argues that Mandecki requires oligonucleotides in a form suitable for hybridization and therefore does not teach double stranded nucleic acids. This argument fails to consider the claims or the Mandecki reference. Claim 1 is simply drawn to producing the nucleic acid. There is no requirement on how the nucleic acid is used. So when Mandecki hybridizes his LSI bound nucleic acid to a target nucleic acid,

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Mandecki "produces" (using the words of the claim) a labeled nucleic acid wherein the nucleic acid is double stranded. This is clearly exemplified by Mandecki in figure 1. Consequently, Applicant's entire argument regarding Mandecki attempts to impute Mandecki's intended methods as teachings regarding the claims. However, Applicant's claim does not limit how the double stranded nucleic acid is produced and Mandecki therefore teaches a method of producing the nucleic acid which meets the claimed requirements.

Applicant then argues that because Akram teaches the elements of RFIID and the size of the memory in separate locations, it is not prima facie obvious to use such elements as taught by Akram with the device of Mandecki. As the Supreme Court noted in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (U.S. 2007),

"The principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* and *Anderson's-Black Rock* are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions."

The Supreme Court notes that the combination of old elements, when predictable, is obvious. In the current case where the LSI of Mandecki is combined with the use of a larger size memory as discussed by Akram, there is no doubt that the method is entirely predictable, since Mandecki expressly notes "The present invention can be

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practiced with different transponders, which might be of different dimensions and have different electronic memory capacity (see column 5, lines 57-60)." So Mandecki is aware that larger memory capacities may be used and Akram teaches that such capacities were well within the state of the prior art.

Further, Applicant is incorrect in the Dystar analysis. Applicant argues that the combination would not make the device better. However, there is no doubt the using the larger memory taught by Akram in the LSI of Mandecki would result in a device with a greater memory capacity, which would permit more information storage. Since Mandecki desires information storage, the use of more memory would improve an element desired by Mandecki.

Applicant makes the same argument with regard to the Nova reference and the argument is not persuasive for the same reasons as given above. Further, Applicant relies upon overcoming this argument in order to overcome the rejections of claim 4. Since these rejections are maintained, so are the rejections over claim 4.

### **Conclusion**

12. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is (571)272-0742. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571)272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jeffrey Fredman  
Primary Examiner  
Art Unit 1637

